



ITW

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Jerome BOUTET et al.

Group Art Unit: 2872

Application No.: 10/724,613

Examiner: A. AMARI

Filed: December 2, 2003

Docket No.: 117911

For: OPTICAL MICROSCOPE WITH MODIFIABLE LIGHTING AND OPERATING
PROCESS OF SUCH A MICROSCOPE

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Election of Species Requirement mailed March 22, 2005, Applicants provisionally elect Species 1, Figure 3. Figures 1, 2, 5, 6, 9 and 10, which are not listed in any of the Species, are included with Figure 3. Applicants submit that claims 1 and 3-9 read on elected Species 1. Applicants note that the alternative embodiment of claims 5 and 6 can be included in Species 1 since both embodiments can use an optical screen transmitting light. It is submitted that at least claim 1 is generic to all species. This election is made with traverse.

It is respectfully submitted that the subject matter of all species is sufficiently related that a thorough search for the subject matter of the elected species would encompass a search for the subject matter of the remaining species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which is stated that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it


includes claims to distinct or independent inventions." (Emphasis added). It is respectfully submitted that this policy should apply in the present application to avoid unnecessary delay and expense to Applicants and duplicative examination by the U.S. Patent and Trademark Office.

Applicants also request rejoinder of non-elected claim 2 if claim 1 is found allowable because claim 1 is generic to claim 2 and thus claim 2 would be allowable for the same reasons that claim 1 is allowable.

Applicants also filed an Information Disclosure Statement with this Response to Election of Species Requirement. It is respectfully requested that the Examiner consider the references cited in that Information Disclosure Statement and the Information Disclosure Statement filed December 2, 2003.

In view of the foregoing, it is respectfully submitted that claims 1-9 can be examined without undue burden on the Examiner. Accordingly, it is respectfully requested that the Election of Species Requirement be withdrawn.

Respectfully submitted,



William P. Berridge
Registration No. 30,024

Scott M. Schulte
Registration No. 44,325

WPB:SMS/sxb

Attachment:
Information Disclosure Statement

Date: April 22, 2005
OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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